UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,271	02/17/2004	Philip C. Hodge	110308-0001	2235

39905   7590   02/20/2008
ROETZEL AND ANDRESS
222 SOUTH MAIN STREET
AKRON, OH 44308

EXAMINER
STEVENS, ROBERT

ART UNIT	PAPER NUMBER
2162	

MAIL DATE	DELIVERY MODE
02/20/2008	PAPER

Response Due 5/20/08

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

RECEIVED FEB 25 2009

Sent to Docketing
2/25

DOCKETED

PTOL-90A (Rev. 04/07)

PAGE 23/52 * RCVD AT 5/13/2008 3:24:46 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/0 * DNIS:2738300 * CSID:3303764577 * DURATION (mm-ss):16-02

Office Action Summary	Application No.	Applicant(s)	RECEIVED
	10/780,271	HODGE ET CENTRAL FAX CENTER	
	Examiner	Art Unit	MAY 1 3 2008
	Robert Stevens	2162	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 November 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-16,18,19,22-30,32-34,36-41,43-45 and 47-56* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-16,18,19,22-30,32-34,36-41,43-45 and 47-56* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>05 February 2007</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)	5) ☐ Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) ☐ Other: _____ .

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   Office Action Summary   Part of Paper No./Mail Date 20080212

Application/Control Number: 10/780,271
Art Unit: 2162

DETAILED ACTION

1.   The Office withdraws the previous rejections of the claims under 35 USC § 103(a), in light of the amendment. However, the Office sets forth new rejections of the claims under 35 USC §§101 103(a), in light of the amendment.

Response to Arguments

2.   Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments concerning the rejection of the claims under 35 USC §103(a) appear to be primarily directed to the newly amended claim language. New rejections citing a new reference have been set forth below to address the amended claim language.

Continued Examination Under 37 CFR 1.114

3.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/31/2007 has been entered.

Application/Control Number: 10/780,271   Page 3
Art Unit: 2162

Specification

4.   The disclosure is objected to because of the following informalities: Paragraph [0037] of

page 10 states that "[t]his hardware ... is typical for implementing software of the present

invention". First, it appears that the word "the" is missing from this sentence between

"implementing" and "software". Second, it appears that another word such as "executing" or

"running" may have been intended rather than "implementing", as hardware is not used to

"implement" software. Please correct all such spelling/grammatical/etc. errors in the disclosure.

Appropriate correction is required.

Drawings

5. .   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they

do not include the following reference sign(s) mentioned in the description: the specification

refers to "DMS 100" in numerous places (see for example, paragraph [0044] on page 13), but

the corresponding reference number does not appear to be in the drawings. Corrected drawing

sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid

abandonment of the application. Any amended replacement drawing sheet should include all of

the figures appearing on the immediate prior version of the sheet, even if only one figure is being

amended. Each drawing sheet submitted after the filing date of an application must be labeled in

the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

the changes are not accepted by the examiner, the applicant will be notified and informed of any

Application/Control Number: 10/780,271   Page 4

Art Unit: 2162

required corrective action in the next Office action. The objection to the drawings will not be

held in abeyance.

Claim Objections

6.   **Claims 33 and 56 are objected to** because of the following informalities: Regarding

claim 33, it appears that the word "and" at the end of line 7 is unnecessary, and that a semicolon

";" and the word "and" are missing between "device" and "means" on line 9 of the claim.

Regarding claim 56, there appears to be an extraneous semicolon ";" between "logic" and "and"

on line 14 of the claim. Appropriate correction is required. See MPEP 608.01(m).

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

8.   **Claims 1, 3-16, 18-19, 22-30 and 32 are rejected under 35 U.S.C. 101** because the

claimed invention is directed to non-statutory subject matter.

Application/Control Number: 10/780,271   Page 5
Art Unit: 2162

Independent claims 1, 27 and 32 are directed to software per se (i.e., a software system

or apparatus). See the specification at paragraph [0044] in context of paragraph [0046], which

indicate that the inventive subject matter may be a software "add-in" (i.e.., a plug-in to a

software application). **Claim 1** appears to be directed to a software system comprised of logic

modules intended to be provided to a computer. **Claim 27** appears to be directed to a collection

of software means. **Claim 32** appears to be directed to a collection of software and data

elements.

Each of these claims encompasses a mere collection of software modules and thus each

lacks the necessary physical articles or objects (e.g., hardware elements) to constitute a machine

or a manufacture within the meaning of 35 USC §101. Each of these claims is clearly not a

series of steps or acts to be a process nor is it a combination of chemical compounds to be a

composition of matter. As such, each of these claims fails to fall within a statutory category.

Each claim is, at best, functional descriptive material *per se*.

Claims 3-16, 18-19 and 22-26 depend upon claim 1, and do not correct the deficiencies

of that claim. These claims are likewise rejected.

Claims 28-30 depend upon claim 27, and do not correct the deficiencies of that claim.

These claims are likewise rejected.

Application/Control Number: 10/780,271   Page 6
Art Unit: 2162

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   **Claims 1, 3-19, 22-34, 36-41 and 43-56 are rejected under 35 U.S.C. 103(a)** as being

unpatentable over Kim et al. (US Patent Application Publication No. 2003/0120729, filed as a

continuation of Application no. 08/908544, which was filed on Aug. 7, 1997 and published on

Jan. 26, 2003, hereafter referred to as "Kim") in view of Ferguson et al. (US Patent No.

6,820,094, filed Oct. 8, 1997 and issued Nov. 16, 2004, hereafter referred to as "Ferguson") and

Grefenstette et al. (US Patent Application Publication No. 2004/0205448, provisionally filed on

Aug. 13, 2001 and published on Oct. 14, 2004, hereafter referred to as "Grefenstette").

        Regarding independent claim 1: Kim discloses

A data-management system to be provided to a digital computer terminal for generating a

link in real time between an electronic document opened in a computer application and a

target document, said digital computer terminal comprising a computer readable memory

and a data-capture device, (See the Abstract and paragraphs [0012] – [0014] in Kim,

discussing automatic link generation between a target and an HTML document opened in a

browser application upon scanning a document into a target file digital format) **said data-**

Application/Control Number: 10/780,271   Page 7
Art Unit: 2162

management system comprising: data-capture logic for controlling capture of electronic

data by said data-capture device; (See Figure 4 #4 in Kim, showing the use of a scanner.)

target-document logic for generating said target document from said electronic data; and

(See paragraph [0012] in Kim, discussing inputting a document to a scanner or fax and creating a

file.) **link-generating logic for substantially simultaneously storing said target document in**

said computer readable memory and generating said link to said target document in said

electronic document in real time; (See paragraphs [0012] – [0014] in Kim, discussing

automatic link generation and storage and noting that paragraph [0014] discusses retrieval of the

created image file, which inherently required that the file be stored before being retrieved.).

data-management logic for transmitting said electronic document and said target

document to a data storage device (See paragraphs [0013] – [0014] in Kim, discussing the

storage of documents.)

However, Kim does not explicitly teach *wherein said data management logic and said*

link editing logic automatically updates the path of said link to maintain functionality of said

link following said transmission Ferguson, though, suggests this limitation. (See column 3

lines 59-65 in Ferguson, discussing updating the STG data storage file, in the context of column

7 lines 47-57, discussing a scenario involving link generation due to "the modification of its

corresponding document".)

It would have been obvious to one of ordinary skill in the art at the time of the invention

to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with

Application/Control Number: 10/780,271   Page 8
Art Unit: 2162

an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate

and archive electronic documents, as taught by Ferguson in the Abstract. These references were

all applicable to the same field of endeavor, i.e., the management of electronic documents.

Additionally, Kim does not explicitly teach *and link-editing logic for updating a path of*

said link Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295]

discussing the dynamic updating of links.)

It would have been obvious to one of ordinary skill in the art at the time of the invention

to apply the teachings of Grefenstette for the benefit of Kim in view of Ferguson, because to do

so provided a user with a system for enriching or supplementing the document that the user is

accessing, as taught by Grefenstette in the Abstract. These references were all applicable to the

same field of endeavor, i.e., the management of electronic documents.

Regarding claim 3: Kim does not explicitly teach the use of top-level directories and

subfolders. Ferguson, though, suggests this limitation. (See Figure 3 and column 4 lines 59-67

in Ferguson, illustrating the use of top-level folder and subdirectories. The specific data one

arranged in a hierarchy was an obvious variant to one skilled in the art at the time of the

invention.)

Application/Control Number: 10/780,271   Page 9
Art Unit: 2162

Regarding claim 4: Kim teaches the use of hard disk data storage. (See Figure 1 #3 in Kim, showing a file server computer, it having been well-known in the art that file server computers contain a hard drive.

Regarding claim 5: Kim does not explicitly teach printing. Ferguson, though, suggests this limitation. (See column 11 lines 29-32 in Ferguson, discussing a utility for viewing and printing documents.)

Regarding claims 7-12: Kim does not explicitly teach the recited limitations. Ferguson, though, suggests these limitations. (See column 10 lines 9-11 in Ferguson, discussing the processing of multipage documents, and column 15 lines 34-40, discussing the linking of a plurality of documents to/from a compound document. Establishing links, whether in a 1:1, 1:MANY, MANY:1 or MANY:MANY fashion, was an obvious variant to one skilled in the art at the time of the invention.)

Regarding claim 13: Kim does not explicitly teach link removal. Ferguson, though, suggests this limitation. (See column 7 lines 53-57 in Ferguson, discussing the removal of only the link.)

Application/Control Number: 10/780,271   Page 10
Art Unit: 2162

Regarding claims 15-18: Kim does not explicitly teach the recited limitations.

Ferguson, though, suggests the use of an add-in. (See Figure 12 in Ferguson, showing the

display results for a browser application add-in.) Ferguson also suggests the use of a data

management system. (See the Abstract of Ferguson, discussing a document management

application program, it having been an obvious variant to one skilled in the art at the time of the

invention as to number of software modules and the location of specific functionality in each

module.) Ferguson also suggests link-editing/ updating. (See column 3 lines 59-65 in Ferguson,

discussing the updating of an STG data storage file.) Ferguson teaches the use of icons. (See

column 12 lines 41-52 in Ferguson, discussing the use of icons to represent links.)

Regarding claim 22: Kim does not explicitly teach printing. Ferguson, though, suggests

this limitation. (See column 11 lines 29-32 in Ferguson, discussing a utility for viewing and

printing documents.)

Regarding claims 23-26: Kim does not explicitly teach the recited limitations.

Ferguson, though, suggests these limitations. (See column 10 lines 9-11, discussing the

processing of multipage documents, and column 15 lines 34-40, discussing the linking of a

plurality of documents to/from a compound document. Establishing links, whether in a 1:1,

1:MANY, MANY:1 or MANY:MANY fashion, was an obvious variant to one skilled in the art

at the time of the invention.)

        Regarding independent claim 27: Kim discloses

        A data-management system for generating a plurality of links to target documents

in an electronic document, (See the Abstract and paragraphs [0012] – [0014] in Kim,

discussing automatic link generation between a target and an HTML document opened in a

browser application upon scanning a document into a target file digital format) **said data-**

management system comprising: means for creating and editing said electronic document;

means for generating a plurality of target documents from electronic data captured by a

data-capture device; (See paragraph [0012] in Kim, discussing inputting a document to a

scanner or fax and creating a file object.) **means for storing said plurality of captured target**

documents in a computer readable memory; and means for generating a link at a plurality

of user-selected locations in said electronic document to said plurality of captured target

documents. (See paragraphs [0012] – [0014] in Kim, discussing automatic link generation and

storage and noting that paragraph [0014] discusses retrieval of the created image file, which

inherently required that the file be stored before being retrieved.)

        However, Kim does not explicitly teach editing, generation of a plurality of documents or

use of sequential identifiers. Ferguson, though, suggests editing. (See column 12 lines 8-15 in

Ferguson, discussing an edit menu and editing functions.) Ferguson also suggests the generation

of a plurality of target documents. (See column 15 lines 30-39 in Ferguson, discussing clipped

documents being formed from a plurality of documents such as images, Word documents and

Application/Control Number: 10/780,271   **Page 12**

Art Unit: 2162

HTML files, and column 15 line 63 – column 16 line 6, discussing links to a compound

document from each component target document.) Ferguson further suggests the use of

sequential identifiers for targets. (See column 5 lines 1-15 in Ferguson, discussing the sequential

numbering of documents [e.g., D_1, D_2, etc.].)

It would have been obvious to one of ordinary skill in the art at the time of the invention

to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with

an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate

and archive electronic documents, as taught by Ferguson in the Abstract. These references were

all applicable to the same field of endeavor, i.e., the management of electronic documents.

Additionally, Kim does not explicitly teach *means for updating a path of said plurality*

of hyperlinks in a user selected range of said electronic document. Grefenstette, though,

suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of

links.)

It would have been obvious to one of ordinary skill in the art at the time of the invention

to apply the teachings of Grefenstette for the benefit of Kim in view of Ferguson, because to do

so provided a user with a system for enriching or supplementing the document that the user is

accessing, as taught by Grefenstette in the Abstract. These references were all applicable to the

same field of endeavor, i.e., the management of electronic documents.

Application/Control Number: 10/780,271   Page 13
Art Unit: 2162

Regarding claim 28: Kim does not explicitly teach printing. Ferguson, though, suggests

this limitation. (See column 11 lines 29-32 in Ferguson, discussing a utility for viewing and

printing documents.

Regarding claim 29: Kim teaches "transmitting" documents to storage. (See paragraphs

[0013] – [0014] in Kim, discussing storage of documents.) However, Kim does not explicitly

teach updating link paths. Ferguson, though, suggests this limitation. (See column 3 lines 59-65

in Ferguson, discussing updating the STG data storage file, in the context of column 7 lines 47-

57, discussing a scenario involving updates requiring link elimination.)

Claim 30 is substantially similar to claim 3, and therefore likewise rejected.

Regarding claim 31: Kim does not explicitly teach updating link paths. Ferguson,

though, suggests this limitation. (See column 3 lines 59-65 in Ferguson, discussing updating the

STG data storage file, in the context of column 7 lines 47-57, discussing a scenario involving

updates requiring link elimination.)

Regarding independent claim 32: Kim discloses

A system for linking a target document to a portion of an electronic document in

real time (See the Abstract of Kim, discussing automatic link generation to a scanned document

Application/Control Number: 10/780,271   Page 14
Art Unit: 2162

file), said system comprising: a computer application for generating and editing said

electronic document; (See the Abstract of Kim, discussing the use of a scanner and generation

of an electronic file.) link-generating logic operable with said computer application for

generating a link to said target document, wherein said target document is an electronic

reproduction of a hardcopy document and is to be generated by scanning said hardcopy

document with an optical data-capture device, further wherein said link is to be generated

at approximately the same time as said captured target document is to be saved, and

further wherein said computer application is one of a group consisting of a spreadsheet,

word processor, database, presentation application, and any combination thereof. (See the

Abstract and paragraphs [0012] – [0014] in Ferguson, discussing a browser application and

automatic link generation to an HTML page and storage, in context of [0005], discussing the

scanning of paper documents using an optical data-capture device such as a scanner. It is noted

that paragraph [0014] discusses retrieval of the created image file, which requires that the file be

stored.)

However, Kim does not explicitly teach editing. Ferguson, though, suggests editing.
(See column 12 lines 8-15 in Ferguson, discussing an edit menu and editing functions.) .

It would have been obvious to one of ordinary skill in the art at the time of the invention

to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with

an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate

and archive electronic documents, as taught by Ferguson in the Abstract. These references were

all applicable to the same field of endeavor, i.e., the management of electronic documents.

Application/Control Number: 10/780,271   Page 15
Art Unit: 2162

Additionally, Kim does not explicitly teach *and link-editing logic for updating a path of said link;* Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of links.) *and the link is automatically updated* Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of links.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Grefenstette for the benefit of Kim in view of Ferguson, because to do so provided a user with a system for enriching or supplementing the document that the user is accessing, as taught by Grefenstette in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

Regarding independent claim 33: Kim discloses

A data-management system for linking a portion of an electronic document to a target document, (See the Abstract of Kim, discussing linking an input image) *said data-management system comprising: a data-capture device for capturing electronic data representing an information object;* (See Figure 4 #4 in Kim, showing the use of a scanner.) *means for generating said target document from said electronic data;* (See paragraph [0012] in Kim, discussing inputting a document to a scanner or fax and creating a file.) *a computer readable memory to store said target document; and* (See paragraph [0014] in Kim, which discusses the

Application/Control Number: 10/780,271   Page 16
Art Unit: 2162

retrieval of the created image file, which required that the file be stored before being retrieved. It

is inherent that such data storage required a computer readable memory.) *means for*

substantially simultaneously storing said target document in said computer readable memory

and generating a link to said target document in said electronic document (See paragraphs

[0012] – [0014] in Kim, discussing automatic link generation and storage and noting that

paragraph [0014] discusses retrieval of the created image file, which inherently required that the

file be stored before being retrieved.) **means for transmitting said electronic document and**

said target document to a data storage device. (See paragraphs [0013] – [0014] in Kim,

discussing the storage of documents.)

However, Kim does not explicitly teach *wherein said transmitting means automatically*

updates a path of said link to maintain functionality of said link following transmission.

Ferguson, though, suggests this limitation. (See column 3 lines 59-65 in Ferguson, discussing

updating the STG data storage file, in the context of column 7 lines 47-57, discussing a scenario

involving link generation due to "the modification of its corresponding document".)

It would have been obvious to one of ordinary skill in the art at the time of the invention

to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with

an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate

and archive electronic documents, as taught by Ferguson in the Abstract. These references were

all applicable to the same field of endeavor, i.e., the management of electronic documents.

Application/Control Number: 10/780,271   Page 17

Art Unit: 2162

Additionally, Kim does not explicitly teach *means for updating a path of said plurality*

of hyperlinks in a user-selected range of said electronic document, Grefenstette, though,

suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of

links.)

It would have been obvious to one of ordinary skill in the art at the time of the invention

to apply the teachings of Grefenstette for the benefit of Kim in view of Ferguson, because to do

so provided a user with a system for enriching or supplementing the document that the user is

accessing, as taught by Grefenstette in the Abstract. These references were all applicable to the

same field of endeavor, i.e., the management of electronic documents.

Regarding claim 34: Kim teaches the use of a scanner. (See paragraph [0012] of Kim.)

Claims 36-37 are substantially similar to claims 3-4, respectively, and therefore likewise

rejected. It is further noted that the exact "means" (e.g., hardware or software element) in which

a particular functionality was implemented, was an obvious variant to one skilled in the art at the

time of the invention.

Application/Control Number: 10/780,271   **Page 18**
Art Unit: 2162

Regarding claims 38-39: Kim does not explicitly teach printing. Ferguson, though,

suggests this limitation. (See column 11 lines 29-32, discussing a utility for viewing and printing

documents.)

Regarding independent claim 40: Kim discloses

An electronic-document management method for creating and managing an electronic

document having a link to a target document in a computer application, (See the Abstract and

paragraphs [0012] – [0014] in Kim, discussing automatic link generation between a target and an

HTML document opened in a browser application upon scanning a document into a target file

digital format) *said method comprising the steps of: generating said target document from*

electronic data representing an information object captured by a data-capture device; and (See

paragraph [0012] in Kim, discussing inputting a document to a scanner or fax and creating a file

object.) *substantially simultaneously storing said target document in a computer readable*

memory and generating said link at said user-selected location in said electronic document.

(See paragraphs [0012] – [0014] in Kim, discussing automatic link generation and storage and

noting that paragraph [0014] discusses retrieval of the created image file, which inherently

required that the file be stored before being retrieved.) **transmitting said electronic document**

and said target document to a data storage device upon receiving a command from a user;

(See paragraphs [0013] – [0014] in Kim, discussing the storage of documents.)

Application/Control Number: 10/780,271   Page 19
Art Unit: 2162

However, Kim does not explicitly teach *and updating a path of said link to render said link operable after said transmission*. Ferguson, though, suggests this limitation. (See column 3 lines 59-65 in Ferguson, discussing updating the STG data storage file, in the context of column 7 lines 47-57, discussing a scenario involving link generation due to "the modification of its corresponding document".)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate and archive electronic documents, as taught by Ferguson in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

Additionally, Kim does not explicitly teach *and updating the path of said link* Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of links.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Grefenstette for the benefit of Kim in view of Ferguson, because to do so provided a user with a system for enriching or supplementing the document that the user is accessing, as taught by Grefenstette in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

Application/Control Number: 10/780,271   Page 20
Art Unit: 2162

      Regarding claim 41: Kim does not explicitly teach document viewing. Ferguson,

though, suggests this limitation. (See Figure 1 element #169 and column 11 lines 28-32 in

Ferguson, discussing document viewing.

      Claim 43 is substantially similar to claim 3, and therefore likewise rejected.

      Regarding claim 44: Kim does not explicitly teach printing. Ferguson, though, suggests

this limitation. (See column 11 lines 29-32 in Ferguson, discussing a utility for viewing and

printing documents.)

      Claim 45 is substantially similar to claim 18, and therefore likewise rejected.

      Claim 46 is substantially similar to claim 17, and therefore likewise rejected. It is further

noted that manual intervention or automatic updating, were obvious variants in light of each

other to one skilled in the art at the time of the invention.

      Regarding independent claim 47: Kim discloses

      An electronic-document management method for creating and managing an

electronic document having a plurality of links to target documents in a computer

application, (See the Abstract and paragraphs [0012] – [0014] in Kim, discussing automatic

Application/Control Number: 10/780,271   Page 21
Art Unit: 2162

link generation between a target and an HTML document opened in a browser application upon

scanning a document into a target file digital format. It was an obvious variant to one skilled in

the art at the time of the invention to include more than one link.) **said method comprising the**

steps of: generating a plurality of target documents from electronic data representing one

or more information objects captured by a data-capture device; (See paragraph [0012] in

Kim, discussing inputting a document to a scanner or fax and creating a file object.) **generating**

one or more links to the target documents in said electronic document. (See the Abstract and

paragraphs [0012] – [0014] in Kim, discussing automatic link generation between a target and an

HTML document opened in a browser application upon scanning a document into a target file

digital format. It was an obvious variant to one skilled in the art at the time of the invention to

include more than one link.)

However, Kim does not explicitly teach **editing, generation of a plurality of documents**

or use of sequential identifiers. Ferguson, though, suggests editing. (See column 12 lines 8-15

in Ferguson, discussing an edit menu and editing functions.) Ferguson also suggests the

generation of a plurality of target documents. (See column 15 lines 30-39 in Ferguson,

discussing clipped documents being formed from a plurality of documents such as images, Word

documents and HTML files, and column 15 line 63 – column 16 line 6, discussing links to a

compound document from each component target document.) Ferguson further suggests the use

of sequential identifiers for targets. (See column 5 lines 1-15 in Ferguson, discussing the

sequential numbering of documents [e.g., D_1, D_2, etc.].)

Application/Control Number: 10/780,271   Page 22
Art Unit: 2162

It would have been obvious to one of ordinary skill in the art at the time of the invention

to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with

an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate

and archive electronic documents, as taught by Ferguson in the Abstract. These references were

all applicable to the same field of endeavor, i.e., the management of electronic documents.

Additionally, Kim does not explicitly teach *and updating the path of said link.*

Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295] discussing the

dynamic updating of links.)

It would have been obvious to one of ordinary skill in the art at the time of the invention

to apply the teachings of Grefenstette for the benefit of Kim in view of Ferguson, because to do

so provided a user with a system for enriching or supplementing the document that the user is

accessing, as taught by Grefenstette in the Abstract. These references were all applicable to the

same field of endeavor, i.e., the management of electronic documents.

Claims 48-49 are substantially similar to claim 42 and claim 3, respectively, and

therefore likewise rejected.

Application/Control Number: 10/780,271   Page 23
Art Unit: 2162

      Regarding claim 50: Kim does not explicitly teach printing. Ferguson, though, suggests this limitation. (See column 11 lines 29-32 in Ferguson, discussing a utility for viewing and printing documents.)

      Regarding claim 51: Kim does not explicitly teach the use of icons. Ferguson teaches the use of icons. (See column 12 lines 41-52 in Ferguson, discussing the use of icons to represent links.)

      Regarding claim 52: Kim does not explicitly teach updating link paths. Ferguson, though, suggests this limitation. (See column 3 lines 59-65 in Ferguson, discussing updating the STG data storage file, in the context of column 7 lines 47-57, discussing a scenario involving updates requiring link elimination.)

      Regarding claim 53: Kim does not explicitly teach user selected link locations, comparing the number of locations with the number of documents to be linked and generating a link for each document. Ferguson, though, suggests these limitations. (See column 9 lines 51-65 in Ferguson, discussing updating the importing documents, and column 9 lines 27-31, discussing the linking of multiple documents.)

Application/Control Number: 10/780,271   Page 24
Art Unit: 2162

       Claims 54-55 are substantially similar to claims 24-25, respectively, and therefore

likewise rejected.

       Regarding independent claim 56: Kim discloses

A data-management system for generating a hyperlink in real time between a portion of an

electronic document opened in a computer application and a target document, (See the

Abstract and paragraphs [0012] – [0014] in Kim, discussing automatic link generation between a

target and an HTML document opened in a browser application upon scanning a document into a

target file digital format. It was an obvious variant to one skilled in the art at the time of the

invention to include more than one link.) *said system comprising: a digital computer terminal*

comprising a computer readable memory and a data-capture device; (See Figure 2 #88 and

#82 of Kim) *data-capture logic in communication with said digital computer terminal for*

controlling capture of electronic data by said data-capture device; (See The Kim Figure 2 #80,

81 and 82, in context of paragraph [0012] discussing the use of a scanner.) *target-document*

logic in communication with said digital computer terminal for generating said target

document from said electronic data; (See the Abstract of Kim, discussing generation of a target

document via a scanning process for display in a browser.) *link-generating logic in*

communication with said digital computer terminal for substantially simultaneously storing

said target document in said computer readable memory and generating said link to said

target document in said electronic document in real time; (See the Abstract and paragraphs

[0012] – [0014] in Kim, discussing automatic link generation between a target and an HTML

document opened in a browser application upon scanning a document into a target file digital

Application/Control Number: 10/780,271   Page 25
Art Unit: 2162

format. It was an obvious variant to one skilled in the art at the time of the invention to include

more than one link.) *data-management logic for transmitting said electronic document and*

said target document to a data storage device. (See paragraphs [0013] – [0014] in Kim,

discussing the storage of documents.)

However, Kim does not explicitly teach *wherein said data-management logic*

automatically updates a path of said link to maintain functionality of said link following said

transmission. Ferguson, though, suggests this limitation. (See column 3 lines 59-65 in

Ferguson, discussing updating the STG data storage file, in the context of column 7 lines 47-57,

discussing a scenario involving link generation due to "the modification of its corresponding

document".)

It would have been obvious to one of ordinary skill in the art at the time of the invention

to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with

an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate

and archive electronic documents, as taught by Ferguson in the Abstract. These references were

all applicable to the same field of endeavor, i.e., the management of electronic documents.

Additionally, Kim does not explicitly teach *link-editing logic for updating a path of said*

link; Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295]

discussing the dynamic updating of links.) *and said link updating logic for updating a path of*

said link automatically updates a path of said link to maintain functionality of said link

Application/Control Number: 10/780,271   Page 26

Art Unit: 2162

following said transmission. Grefenstette, though, suggests this limitation. (See Grefenstette

paragraph [0295] discussing the dynamic updating of links.)

It would have been obvious to one of ordinary skill in the art at the time of the invention

to apply the teachings of Grefenstette for the benefit of Kim in view of Ferguson, because to do

so provided a user with a system for enriching or supplementing the document that the user is

accessing, as taught by Grefenstette in the Abstract. These references were all applicable to the

same field of endeavor, i.e., the management of electronic documents.

Application/Control Number: 10/780,271   Page 27

Art Unit: 2162

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

US Patent Application Publications

Meier et al	2002/0083079
Omoigui	2003/0126136

US Patents

Grefenstette et al	7,284,191
Smith et al	6,052,693
Peairs	6,182,090
Combs	6,138,129
Peairs	5,903,904
Peairs	5,717,940

Application/Control Number: 10/780,271   Page 28
Art Unit: 2162

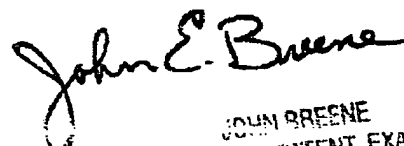### *Contact Information*

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Robert Stevens whose telephone number is (571) 272-4102. The

examiner can normally be reached on M-F 6:00 – 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert Stevens
Examiner
Art Unit 2162

February 14, 2008

JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

		Application/Control No. 10/780,271	Applicant(s)/Patent Under Reexamination HODGE ET AL	
Notice of References Cited		Examiner Robert Stevens	Art Unit 2162	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,182,090	01-2001	Peairs, Mark	715/209
*	B	US-6,138,129	10-2000	Combs, J. Andrew	707/6
*	C	US-5,903,904	05-1999	Peairs, Mark	715/209
*	D	US-5,717,940	02-1998	Peairs, Mark	715/209
*	E	US-2004/0205448	10-2004	Grefenstette et al.	715/500
*	F	US-2003/0126136	07-2003	Omoigui, Nosa	707/10
*	G	US-7,284,191	10-2007	Grefenstette et al.	715/230
*	H	US-6,052,693	04-2000	Smith et al.	707/104.1
*	I	US-2002/0083079	06-2002	Meier et al.	707/104.1
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

U.S. Patent and Trademark Office
PTO-892 (Rev. 01-2001)   Notice of References Cited   Part of Paper No. 20080212